REMARKS

I.   **Introduction**

Claims 10-11 and 14-18 are pending in the present application after cancellation of claims 12 and 13. Claim 10 has been amended to incorporate the features of now-canceled claims 12 and 13. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims 10-11 and 14-18 are allowable, and reconsideration of the pending claims is respectfully requested.

II.   **Rejection of Claims 10-18 in View of "Abraham" and "Kousa"**

Claims 10-18 were rejected under 35 U.S.C. § 103(a) as being obvious in view of the combination of U.S. Patent 5,745,576 ("Abraham") and U.S. Patent 4,797,672 ("Kousa"). Applicants respectfully submit that this rejection should be withdrawn for the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine the reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The prior art must suggest combining the features in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296; In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a " basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claim 10, as amended, recites the following:

10. (Currently Amended) A system for controlling an access authorization, comprising:

a base device including a computer, wherein the base device initially transmits a prompt signal within a framework of an initial prompt/reply cycle that is successfully carried out, **and wherein the prompt signal is stored in the base device**; and

at least one remote control storing the initially transmitted prompt signal from the initial prompt/reply cycle;

wherein, in an access authorization process, subsequent to the previous, initial prompt/reply cycle that is successfully carried out, the at least one remote control transmits to the base device a code word containing a reply, the reply being formed at least partially as a function of the prompt signal stored in the at least one remote control, wherein the base device receives the code word containing the reply and compares the reply contained in the code word with a required reply, wherein an access is authorized if the reply contained in the code word agrees with the required reply, **and wherein the prompt signal stored in the base device is erased when a number of failed agreements of the reply and the required reply exceeds a specifiable limiting value.**

As shown above, the system for controlling an access authorization as recited in claim 10 includes a remote control that stores the prompt signal sent by the base device in a previously successfully performed prompt/reply cycle, and in a subsequent access authorization attempt the remote control transmits to the base device a code word containing a reply that is "formed at least partially as a function of the prompt signal stored in the at least one remote control, . . . wherein an access is authorized if the reply contained in the code word agrees with the required reply, and wherein **the prompt signal stored in the base device is erased when a number of failed agreements of the reply and the required reply exceeds a specifiable limiting value.**" In contrast to the above-recited features of claim 10, as well as in contrast to the Examiner's assertions, Abraham does not teach or suggest these features, as explained in detail below.

In support of the rejection, the Examiner "takes official notice that it is well known in the art to check failed attempts to connect, and to **abandon an access process** after a predetermined number of failures," and therefore, the Examiner concludes that it would have been obvious "to use this check in Abraham's system to avoid eternal loops, and to increase security against hacking." (Office Action, p. 3). Since the Examiner appears to be relying on personal knowledge for the asserted official notice, and since the Examiner has not provided "specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge," Applicants respectfully traverse the Examiner's official notice, and Applicants request that the Examiner provide a documentary support for the conclusion contained in the official notice. (See MPEP 2144.03B).

Independent of the above, even if one assumed for the sake of argument that the Examiner's official notice were correct (with which assumption Applicants do not agree), the Examiner's official notice does not adequately support the obviousness conclusion because "**abandon[ing] an access process** after a predetermined number of failures" clearly is not equivalent to the claimed <u>erasing</u> of "**the prompt signal stored in the base device . . . when a number of failed agreements of the reply and the required reply exceeds a specifiable limiting value,**" as recited in amended claim 10. In particular, the access procedure may be abandoned without explicitly erasing the prompt signal stored in the base device, and the access procedure may also be repeated without explicit erasing of the prompt signal stored in the base device. In any case, to the extent that the Examiner may be somehow relying on the doctrine of inherent disclosure, it is quite clear that the Examiner has failed to provide the requisite " basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics [i.e., erasing the prompt signal stored in the base device] <u>necessarily</u> flow from the teachings of the applied art [i.e., the official notice regarding "abandoning an access process"]. Alternatively, to the extent the Examiner may be contending that the claimed feature of erasing "the prompt signal stored in the base device . . . when a number of failed agreements of the reply and the required reply exceeds a specifiable limiting value" is well known in the art, Applicants respectfully traverse the Examiner's contention as being, at best, a mere hindsight reconstruction based on an "obvious-to-try" rationale, which is clearly impermissible. (See MPEP 2143.01 III & IV).

In addition to the above, Applicants note that Kousa clearly does not remedy the deficiencies of Abraham as applied against claim 10. Accordingly, for at least the

foregoing reasons, claim 10 and its dependent claims 11 and 14-18 are not rendered obvious by the combination of Abraham and Kousa.

III.   Rejection of Claims 10-18 under 35 U.S.C. § 103(a) in View of "Schneier"

Claims 10-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the publication Applied Cryptography ("Schneier"). Applicants respectfully submit that this rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine the reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The prior art must suggest combining the features in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296; In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a " basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Amended claim 10 recites, in relevant parts, a system for controlling an access authorization which includes a remote control that stores the prompt signal sent by the base device in a previously successfully performed prompt/reply cycle, and in a subsequent access authorization attempt the remote control transmits to the base device a code word containing a reply that is "formed at least partially as a function of the prompt signal stored in the at least one remote control, . . . wherein an access is authorized if the reply contained in the code

word agrees with the required reply, and wherein **the prompt signal stored in the base device is erased when a number of failed agreements of the reply and the required reply exceeds a specifiable limiting value.**"

In support of the rejection, the Examiner "takes official notice that authentication by encrypting a unique identifier is well known in the art," and the Examiner "takes official notice that session keys are temporary, and it is well known to keep count of their uses." Therefore, the Examiner concludes that it would have been obvious "to keep count of transitions to know when to expire the session key." (Office Action, p. 3). Since the Examiner appears to be relying on personal knowledge for the asserted official notice, and since the Examiner has not provided "specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge," Applicants respectfully traverse the Examiner's official notice, and Applicants request that the Examiner provide a documentary support for the conclusion contained in the official notice. (See MPEP 2144.03B).

Independent of the above, Applicants note that the Examiner is taking official notices of essentially all of the claimed limitations other than the "base device" limitation, and the Examiner does not even address the claimed features specifically. In this regard, Applicants note that the Examiner has failed to establish a *prima facie* case of obviousness since the Examiner has not even specifically discussed all of the claimed features, let alone provide any prior art reference that would even begin to support the Examiner's conclusion. Even if one assumed for the sake of argument that the Examiner's official notice were correct (with which assumption Applicants do not agree), the Examiner's official notice does not adequately support the obviousness conclusion because "to keep count of transitions to know when to <u>expire the session key</u>" (as asserted by the Examiner) is not necessarily equivalent to the claimed **erasing** of "**the prompt signal stored in the base device . . . when a number of failed agreements of the reply and the required reply exceeds a specifiable limiting value,**" as recited in amended claim 10. In any case, to the extent that the Examiner may be somehow relying on the doctrine of inherent disclosure, it is quite clear that the Examiner has failed to provide the requisite "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics [i.e., erasing the prompt signal stored in the base device] <u>necessarily</u> flow from the teachings of the applied art [i.e., the official notice regarding "expire the session key"]. To the extent the Examiner may be

contending that the claimed feature of erasing "the prompt signal stored in the base device . . . when a number of failed agreements of the reply and the required reply exceeds a specifiable limiting value" is well known in the art, Applicants respectfully traverse the Examiner's contention as being, at best, a mere hindsight reconstruction based on an "obvious-to-try" rationale, which is clearly impermissible. (See MPEP 2143.01 III & IV).

For at least the foregoing reasons, claim 10 and its dependent claims 11 and 14-18 are not rendered obvious by Schneier.

CONCLUSION

Applicants respectfully submit that all pending claims of the present application are now in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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